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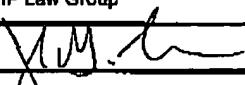
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Application Number	09/774,968
Filing Date	01/31/2001
First Named Inventor	Zebian
Art Unit	2164
Examiner Name	Patel
Attorney Docket Number	U000-P02026US

**RECEIVED****CENTRAL FAX CENTER****MAR 16 2005****ENCLOSURES (Check all that apply)**

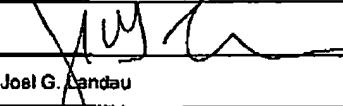
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**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name	SoCal IP Law Group		
Signature			
Printed name	Joel G. Landau		
Date	March 16, 2005	Reg. No.	54,732

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl. No. : 09/774,968 Confirmation No. 6029

Applicant : Zebian, Marwan

Filed : 01/31/2001

TC/A.U. : 2154

Examiner : Patel, Ashokkumar B

Docket No. : U00-P02026US

Customer No. : 33356

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**Reply Brief Under 37 C.F.R. § 41.41**

Dear Sir:

The following Reply Brief is submitted in response to the Examiner's Answer mailed March 4, 2005.

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Reply Brief Dated 3/16/2005  
Response to Examiner's Answer action dated 03/04/2005

#### A. Rejection of Claims 1-11 as Unpatentable over West

To anticipate a claim under 35 U.S.C. § 102, the reference must teach each and every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 USPQ2d 1051, 1053 (Fed. Cir. 1987).

##### **(1) West Does Not Teach a User NAN List that is a Subset of an Available NAN List**

Claim 1 is independent. Claim 1 recites, among other limitations, "wherein the user NAN list comprises a subset of the available NAN list." In the Appeal Brief, the Appellant asserted that West did not teach the claimed feature at 3:35-45 and Fig. 4 element 334. In the Examiner's Answer, the Examiner did not contest this logic and therefore it must be concluded that the Examiner agreed with the Appellant. However, the Examiner, in his answer, asserted that another portion of West taught this feature:

The reference further teaches in col. 6, lines 8-22, "The 'calling to' information 224 is an identifier of a particular access point within corporate communication system 140 to which the user wants to be connected. For example, in a geographically distributed corporate communication system, the user may specify the particular location to which the user wants to be connected. Access points can be associated with an Internet address or a telephone number of a server computer coupled to a corporate communication system 140. The 'calling from' field 222 and the 'calling to' field can each present an asset of choices from which the user may select one, or the user can enter another value that is not in the set of presented choices. The choices are in part preconfigured into the system by an administrator of the system, and can also include recently used field values." (page 5, line 17 – page 6, line 5 of Examiner's Answer)

This portion of West describes "calling from" information and "calling to" information. Because presenting the "calling to" information in West is akin to presenting the entire available NAN list, claim 1 is patentable over West. More specifically, "calling from" information is the telephone number that the remote computer is using to connect to the corporate communication

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system (see West, 5:64 - 6:6). "Calling to" information is a list of telephone numbers that the remote computer may call to connect to the corporate communication system. As such, there is nothing in West, at 6:8-22, that teaches that a first list is a subset of a second list, and more specifically, there is nothing in West that teaches that a NAN that is a subset of an available NAN list as recited in claim 1. West, at 6:20-22, describing that "[t]he choices are in part preconfigured into the system by an administrator of the system" does not teach that the user NAN list is a subset of the available NAN list.

The Examiner also stated, in reference to West, that:

The reference also teaches in col. 6, lines 37-58, "Alternatively, the user can press (e.g., activating using a mouse) a 'more' button 228 to view information related to the connection that would be established if the user were to connect at that point. In response, as indicated in FIG. 2(c), possible communication paths identified by the connection software to couple remote computer 100 and the selected access point within corporate communication system 140 are presented in a list of connection paths 232." (page 6, lines 5 - 11 of Examiner's Answer)

This portion of West describes presenting the user with a list of connection paths for connecting to the corporate communication system. Because this portion of West fails to teach a user NAN list that is a subset of an available NAN list, claim 1 is patentable over West. More specifically, the user may select one of the connection paths or may enter their own. Although the list of connection paths is arguably similar to a NAN list, West, at 6:37-58, does not teach that the list of connection paths is a subset of a larger group of connection paths. Moreover, the ability to "press a more button" and review "information related to the connection" is irrelevant to the user NAN list being a subset of the available NAN list.

Because the cited portions of West do not teach a user NAN list that is a subset of an available NAN list as claimed, the Examiner has not met the required showing that West teaches all of the limitations recited in claim 1. Moreover, review of the entirety of West shows that West fails

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to teach a user NAN list that is a subset of an available NAN list. As such, the rejection should be reversed.

**(2) West Does Not Teach Setting an Order for Selecting NANs in a User NAN List Based Upon Connection Information Wherein the Order is Set Outside the User's Control**

Claim 1 recites, among other limitations, "setting an order for selecting the NANs in the user NAN list based upon the connection information wherein the order is set outside of the user's control." The preamble of claim 1 recites, "the NANs for use by a user's client device in connecting to a data network under control of a server system." In the Appeal Brief, the Appellant asserted that West did not teach the claimed features at 2:58-63. In the Examiner's Answer, the Examiner did not contest this logic and therefore it must be concluded that the Examiner agreed with the Appellant. However, the Examiner, in his answer, asserted that another portion of West taught this feature:

The reference further teaches in col. 6, lines 40-48, 'In response, as indicated in FIG. 2(c), possible communication paths identified by the connection software to couple remote computer 100 and the selected access point within corporate communication system 140 are presented in a list of connection paths 232. The list is sorted so that the first entry in the list is the path preferred by the connection software. Preference is based on a calculated cost for each of the paths, including both monetary and performance related factors.' Thus the NAN list is presented to the remote user by 'setting an order for selecting the NANs in the user NAN list based upon the connection information wherein the order is set outside of the user's control. (page 8, line 14 – page 9, line 2 of Examiner's Answer, emphasis added)

This portion of West describes setting an order for the connection path list that is presented to the user where the order is based on cost and performance. However, West, at 6:40-48, describes presenting an ordered list of connection paths to a user so that the user may select one of the numbers to connect to. In West, the user selects from the list of connection paths which connection path to use to connect to the remote computer. In contrast, the NANs of claim 1 are "for use by a user's client device in connecting to a data network under control of a server system."

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Because the cited portion of West does not teach setting an order for selecting the NANs in the user NAN list based upon the connection information wherein the order is set outside of the user's control, as claimed, the Examiner has not met the required showing that West teaches what is recited in claim 1. As such, the rejection should be reversed.

By virtue of their dependency on claim 1, claims 2-11 are patentable over West. As such, the anticipation rejection of the claims 2-11 should be reversed.

**B. Rejection of Claims 12-25 and 30-35 as Unpatentable over West in view of Dieterman**

"To establish a *prima facie* case of obviousness, [ . . . ] the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**(1) West in view of Dieterman Does Not Teach or Suggest a User NAN List That is a Subset of an Available NAN List**

Claims 12 and 30 are independent. Claims 12 and 30 recite, among other limitations, "wherein the user NAN list comprises a subset of the available NAN list." As argued above in the "Rejection of Claims 1-11 as Upatentable over West" section, West does not teach this feature. Moreover, the Examiner has not set forth how Dieterman teaches this feature. Because neither West nor Deiterman teach or suggest the claimed feature, the rejection should be reversed.

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**(2) West in view of Dieterman Does Not Teach or Suggest Transmitting an Identification of the NANs in the User NAN List from the Client Device to the Online Service Provider Server System**

Claim 12 recites, among other limitations, "transmitting an identification of the NANs in the user NAN list from the client device to the online service provider server system." In the Appeal Brief, the Appellant asserted that West did not teach the claimed features at Figs. 2a ~ 2c. The Examiner stated in his answer, in reference to West, that:

The claimed feature clearly indicates that what is being transmitted is 'an identification of the NANs in the user NAN list' such as 'calling to' (phone number) as shown in West's Figs. 2a-2c from a given 'Alternatively, the user can press (e.g., activating using a mouse) a 'more' button 228 to view information related to the connection that would be established if the user were to connect at that point. In response, as indicated in FIG. 2(c), possible communication paths identified by the connection software to couple remote computer 100 and the selected access point within corporate communication system 140 are presented in a list of connection paths 232.' In col. 6, line 37-44, and 'Having viewed, and possibly modified the order of connection paths 232, the user initiates the connection procedure by activating 'connect' button 226.' In col. 6, lines 55-58. Thus the reference West teaches, 'transmitting an identification of the NANs in the user NAN list from the client device to the server system.' (page 10, line 16 – page 11, line 6 of Examiner's Answer)

This portion of West describes that the user selects a "calling to" telephone number from a list of access points to the corporate communication system. "The 'calling to' information 224 is an identifier of a particular access point within the corporate communication system 140 to which the user wants to be connected." (see West, 6:8-11) Once West's user selects the "calling to" identifier and presses the "connect" button (see West, 6:33-36), the remote computer connects to the access point of the corporate communication system associated with the "calling to" identifier. The "identifier" of West is merely a graphical user interface item. In contrast, the term "identification", as recited in claim 12, identifies if a NAN in the user NAN list is in the available NAN list ("good NAN") or if a NAN in the user NAN list is not in the available NAN list ("bad NAN") (see

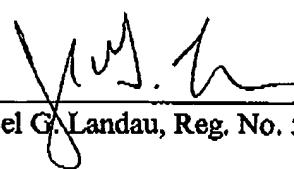
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Specification page 21 paragraph [0059]). As such, the "identification" of claim 12 is not the same as and is not taught by the "identifier" of West. Moreover, West does not teach or suggest transmitting where an identifier is transmitted from the client device to the online service provider server system.

Because neither West nor Deiterman teach or suggest "transmitting an identification of the NANs in the user NAN list from the client device to the online service provider server system", the rejection should be reversed. By virtue of their respective dependency on claims 12 and 30, claims 13-25 and 31-32 are patentable over West in view of Dieterman. As such, the obviousness rejection of the claims 13-25 and 30-32 should be reversed.

Respectfully submitted,

Date: March 16, 2005

  
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